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FEE TRANSMITTAL **for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 500.00
Complete If Known

| | |
|----------------------|---------------------|
| Application Number | 09/895,098 |
| Filing Date | June 29, 2001 |
| First Named Inventor | Kulvir Singh Bhogal |
| Examiner Name | Gabriel I. Garcia |
| Art Unit | 2624 |
| Attorney Docket No. | AUS920010272US1 |

METHOD OF PAYMENT (check all that apply)
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Deposit Account Number: 50-0714/IBM/0010

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| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description | Fee Paid |
|----------------------------|----------------------------|------------------------|-------------|
| 1001 770 | 2001 385 | Utility filing fee | |
| 1002 340 | 2002 170 | Design filing fee | |
| 1003 530 | 2003 265 | Plant filing fee | |
| 1004 770 | 2004 385 | Reissue filing fee | |
| 1005 180 | 2005 80 | Provisional filing fee | |
| SUBTOTAL (1) | | | (\$) |

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| Independent | -20** = | X | |
| Multiple Dependent | -3** = | X | |

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description |
|----------------------------|----------------------------|--|
| 1202 18 | 2202 9 | Claims in excess of 20 |
| 1201 88 | 2201 43 | Independent claims in excess of 3 |
| 1203 280 | 2203 145 | Multiple dependent claim, if not paid |
| 1204 88 | 2204 43 | ** Reissue independent claims over original patent |
| 1205 18 | 2205 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description | Fee Paid |
|----------------------------|----------------------------|--|----------|
| 1051 130 | 2051 65 | Surcharge - late filing fee or oath | |
| 1052 60 | 2052 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 130 | 1053 130 | Non-English specification | |
| 1812 2,520 | 1812 2,520 | For filing a request for ex parte reexamination | |
| 1804 920* | 1804 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 1,840* | 1805 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 110 | 2251 55 | Extension for reply within first month | |
| 1252 420 | 2252 210 | Extension for reply within second month | |
| 1253 950 | 2253 475 | Extension for reply within third month | |
| 1254 1,480 | 2254 740 | Extension for reply within fourth month | |
| 1255 2,010 | 2255 1,005 | Extension for reply within fifth month | |
| 1401 330 | 2401 165 | Notice of Appeal | |
| 1402 330 | 2402 165 | Filing a brief in support of an appeal | 500.00 |
| 1403 280 | 2403 145 | Request for oral hearing | |
| 1451 1,510 | 1451 1,510 | Petition to institute a public use proceeding | |
| 1452 110 | 2452 55 | Petition to revive - unavoidable | |
| 1453 1,330 | 2453 665 | Petition to revive - unintentional | |
| 1501 1,330 | 2501 665 | Utility issue fee (or reissue) | |
| 1502 480 | 2502 240 | Design issue fee | |
| 1503 640 | 2503 320 | Plant issue fee | |
| 1460 130 | 1460 130 | Petitions to the Commissioner | |
| 1807 60 | 1807 60 | Processing fee under 37 CFR 1.17(q) | |
| 1806 180 | 1806 180 | Submission of Information Disclosure Stmt | |
| 8021 40 | 8021 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 770 | 2809 385 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 770 | 2810 385 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 770 | 2801 385 | Request for Continued Examination (RCE) | |
| 1802 900 | 1802 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 500.00)**SUBMITTED BY**

| | | | | | |
|-------------------|---------------------------|-----------------------------------|------------------|-----------|--------------|
| Name (Print/Type) | Jeffrey L. Streets | Registration No. (Attorney/Agent) | 37,453 | Telephone | 713.939.9444 |
| Signature | <i>Jeffrey L. Streets</i> | Date | January 20, 2006 | | |

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JEFFREY L. STREETS
PATRICK K. STEELE**STREETS & STEELE**
Intellectual Property Attorneys13831 Northwest Freeway, Suite 355
Houston, Texas 77040
(713) 939-9444
Fax (713) 939-9508Patents, Trademarks,
Copyrights, Licensing,
Trade Dress, Trade Secrets,
Unfair Competition,
Technology Development,
Computer and Internet Law

Date: January 20, 2006

To: Examiner Gabriel I. Garcia
USPTO Art Unit: 2624

Facsimile: 571-273-8300

Telephone:

From: Streets & Steele
Melba FuentesOur Ref: AUS920010272US1
(IBM-0010)

Serial No: 09/895,093

Our Deposit Account Log No.: 0121

Confirmation No: 6701

Pages: 22 (with cover)

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- 1) Transmittal Form;
- 2) Fee Transmittal; and
- 3) Appeal Brief.

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Appeal Brief
Dkt. No.: AUS920010272US1
(IBM/0010)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF:
Kulvir Singh Bhogal

SERIAL NO: 09/895,093

CONFIRMATION NO.: 6701

FILED: June 29, 2001

**FOR: Print Manager Having a User Interface
For Specifying How Documents Are
Directed to Print Devices**

.....

EXAMINER: Gabriel I. Garcia

GROUP ART UNIT: 2624

Via Facsimile: 571-273-8300

CERTIFICATE OF TRANSMISSION
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1/20/06 *John F. Hines*
Date Signature

APPEAL BRIEF

**Attorney for Appellant
Jeffrey L. Streets
Registration No. 37,453
13831 Northwest Freeway, Suite 355
Houston, Texas 77040
713-939-9444**

Appeal Brief
Dkt. No.: AUS920010272US1
(IBM/0010)

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| | |
|------------------------|---|
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Appeal Brief
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(IBM/0010)

APPEAL BRIEF

Appellant timely filed a Notice of Appeal to this Board on November 22, 2005 appealing the decision of the Examiner in the Final Office Action dated August 22, 2005 for the above captioned application. Appellant hereby submits this Appeal Brief pursuant to 37 C.F.R. 41.37.

(1) REAL PARTY IN INTEREST

The real party of interest in this action is International Business Machines Corporation, the recorded assignee of the entire right, title and interest in and to the patent application now under appeal before this Board. International Business Machines Corporation is a corporation of the State of New York, having a place of business in Armonk, New York 10504.

(2) RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative, or Assignee that will affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

(3) STATUS OF THE CLAIMS

The status of all claims in the application under appeal is as follows: claims 1-6 and 8-13 are pending in the application. Claims 1-6 and 8-13 stand rejected and are under appeal.

(4) STATUS OF AMENDMENTS

Appellant has not submitted any amendments to the claims subsequent to the Final Office Action dated August 22, 2005. Appellant believes that the amendments made in its Response filed on May 23, 2005 have been entered.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

There are two independent claims involved in this appeal, including independent claim 1 directed to a method and independent claim 8 directed to a computer program product.

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Independent claim 1 is directed to a method for selecting a printer for printing a print job. (Specification, page 4, line 22; original claim 1; Abstract) The method comprises: identifying one or more attributes of the print job (Specification, page 4, line 23; and Figure 6, state 604); associating an attribute bit setting for each of the one or more identified attributes (Specification, page 12, lines 1-3 and 13-17; page 14, lines 1-3; and Figure 6, state 606); matching the one or more attribute bit settings of the print job with attributes listed in an attribute-printer assignment table (Specification, page 12, lines 22-25; page 13, lines 1-9 and 18-20; page 14, lines 1-8; Figure 5; Figure 6, state 610); identifying the printer from the attribute-printer assignment table designated to handle print jobs by having the matching one or more attribute bit settings (Specification, page 13, lines 19-20; page 14, lines 3-6; Figure 6, state 610); and directing the print job to the identified printer (Specification, page 14, lines 6-7; Figure 6, states 612). The method provides the advantage of accommodating user preferences for determining how print jobs are distributed to a plurality of printers (Specification, page 4, lines 14-16; page 4, line 22 to page 5, line 4, page 11, line 1-3 and 12-29; and page 12, lines 22-23).

Independent claim 8 is directed to a computer program product including instructions embodied on a computer readable medium, for selecting a printer for printing a print job (Specification, original claims 8-14). The computer program product comprises instructions for carrying out the steps of the method described above. Accordingly, the specification support for the computer program product includes the description of the method as set out above.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-6 and 8-13 are anticipated under 35 U.S.C. 102(e) by Barry et al., U.S. Patent No. 6,606,165.

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(7) ARGUMENT

Whether claims 1-6 and 8-13 are anticipated under 35 U.S.C. 102(e) by Barry et al., U.S. Patent No. 6,606,165.

(1) Applicable law.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Mashinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984). Under 35 U.S.C. Section 102, anticipation requires that "the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USQP2d 1001, 1010 (Fed. Cir. 1991). Furthermore, the Federal Circuit held in *Paperless Accounting, Inc. v. Bay Area Rapid Transit Systems*, 804 F.2d 659 (Fed. Cir. 1986) that "a §102(b) reference must sufficiently describe the claimed invention to have placed the public in possession of it." *Id.* at 665.

(2) Review of the cited prior art.

U.S. Patent No. 6,606,165 (hereinafter "Barry") discloses a method and apparatus for routing pages of a document to a multi-print engine based on parameters associated with the

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page data of the print job. (Barry, Abstract). After converting the print job into rasterized images of each separate page of the document and storing each of the rasterized images of individual pages in storage, the individual pages are sent to the print engines based upon matching the print job parameters of each rasterized image with the printing characteristics of the print engine selected. (Abstract) The print job parameters that are included in the header of each rasterized page include such things as bit depth of the page, the page size, the number of colors on the page, the number of planes and the resolution. (Barry, col. 31, lines 45-50). However, the assignment to a given printer is not based upon attribute settings but is instead based upon complex formulas. *See*, for example, Barry, col. 9, eqns. (1) and (2); col. 13, line 25.

(3) Barry fails to disclose each of the limitations of independent claim 1.

Appellant claims, *inter alia*, associating an attribute bit setting for each of the one or more identified attributes, matching these bit settings with attributes in an attribute-printer assignment table, identifying the printer from the assignment table designated to handle print jobs having the matching attribute bit settings and directing the print job to the identified printer.

Appellant respectfully asserts that a *prima facie* case of anticipation has not been presented because Barry fails to set forth each and every element of Appellant's claimed invention. First, Barry does not set forth associating an *attribute bit setting* for each of one or more identified attributes of the print job. As known to those having ordinary skill in the art, a bit is a unit of information content equal to one binary decision. (*See*, McGraw-Hill Dictionary of Scientific and Technical Terms). As Appellant disclosed, an attribute may be a color bit where the value "1" indicates that the print job contains color images and the value "0" indicates that the print job is merely black and white. (Specification, p. 12, lines 9-11). The header

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disclosed by Barry as including the relevant properties of each page being printed are not bit settings but general information, such as page size, number of colors, number of planes and resolution. These are not bit settings, the limitation claimed by Appellant.

Neither does Barry set forth matching the bit settings designating the attributes of the print job with attributes listed in an attribute-printer assignment table nor identifying the printer to send the print job by matching attribute bit settings with those in the table.

Because Barry does not set forth each and every element of Appellant's claimed invention, Appellant respectfully requests reconsideration and withdrawal of the rejection of independent claim 1 as well as all claims depending therefrom.

The Examiner states that the "attributes read on the parameters or characteristics" (Final Office Action, page 3, line 3). Appellant asserts that the "attributes of the print job" (Appellant's Claim 1) does not read on "parameters of each bit-mapped image" (Barry, Abstract, lines 12-13) or "characteristics of the print engine" (Barry, Abstract, line 13). Appellant has defined attributes to be representative of a print job, not representative of an image or print engine.

The Examiner has repeatedly cited Barry at col. 31, lines 22-65 as the support for the assertion that Barry teaches certain limitations of all of Appellant's pending claims 1-6 and 8-13. Appellant asserts that these limitations are not specifically found with the cited passage and the generality of the citation, i.e., the same 43 lines for each claim limitation, deprives the Appellant of the opportunity to respond with more particularity. Appellant asserts that the Examiner has not made out a *prima facie* case of anticipation.

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(4) Barry fails to disclose the limitation of dependent claim 4.

Regarding claim 4, Barry does not disclose using a graphical user interface to enter the list of available printers and the attributes associated with each of the available printers. As Appellant discloses, the assignment of available printers to print jobs having certain attributes is preferably customizable by the user through a graphical user interface. (Specification, p. 13, lines 20-23). The method and system disclosed by Barry is extremely complex with many different parameters that must be entered for the many different printer engines disclosed therein. Appellant is unable to find within Barry any disclosure that an attribute-printer assignment table is populated by entering the list of available printers and attributes of the available printers through a graphical user interface. Appellant respectfully asserts that a *prima facie* case of anticipation has not been presented and respectfully requests reconsideration and withdrawal of the rejection of claim 4.

(5) Barry fails to disclose the limitation of dependent claim 5.

Regarding claim 5, Barry does not disclose that an attribute bit setting for each of the one or more identified attributes is set by an application program or printer handler. Barry merely discloses that a page header is generated for each page to be printed and that the page header includes, derived after rasterizing the page to be printed, the bit depth of the page, the page size, the number of colors, etc. (Barry, col. 31, lines 45-55).

It is important to note that Barry requires that a document to be printed be rasterized prior to a determination as to which printer to send the document to. As Barry states:

It should be understood that the virtual print engine of the present invention is operable to convert each of the documents *into single individual bit-mapped pages*, which images are stored on a page-by-

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(IBM/0010)

page basis for each document. Thereafter, as described above, these pages are distributed to various engines in a parallel manner, depending upon the characteristics of the page, the availability of the engine, and, in general, how best to match a given page in accordance with its characteristics with a given engine in accordance with that engine's characteristics.

Barry, col. 16, lines 40-52.

Barry further discloses:

The RIP (which Barry discloses to be the rasterizing program that converts a document into the individual bit-mapped pages), in addition to providing a rasterized image, also provides output information as to bit depth, resolution, number of pixels per line, etc.

Barry, col. 31, lines 40-50.

Barry does not disclose the use of an attribute bit setting for each of one or more identified attributes. Reconsideration and withdrawal of the rejection of claim 5 is requested.

(6) Barry fails to disclose the limitations of independent claim 8.

Barry fails to disclose at least one limitation of the computer program product set out in claim 8. In claim 8, Appellant claims a computer program product including instructions embodied on a computer readable medium for selecting a printer for printing a print job, the instructions comprising: identifying instructions for identifying one or more attributes of the print job, associating instructions for associating an attribute bit setting for each of the one or more identified attributes, matching instructions for matching these bit settings with attributes in an attribute-printer assignment table, identifying instructions for identifying the printer from the assignment table designated to handle print jobs having the matching attribute bit settings, and directing instructions for directing the print job to the identified printer.

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Appellant respectfully asserts that a *prima facie* case of anticipation has not been presented because Barry fails to set forth each and every element of Appellant's claimed invention. First, Barry does not set forth associating instructions for associating an *attribute bit setting* for each of one or more identified attributes of the print job. As known to those having ordinary skill in the art, a bit is a unit of information content equal to one binary decision. (See, McGraw-Hill Dictionary of Scientific and Technical Terms). As Appellant disclosed, an attribute may be a color bit where the value "1" indicates that the print job contains color images and the value "0" indicates that the print job is merely black and white. (Specification, p. 12, lines 9-11). The header disclosed by Barry as including the relevant properties of each page being printed are not bit settings but general information, such as page size, number of colors, number of planes and resolution. These are not bit settings, the limitation claimed by Appellant.

Neither does Barry set forth matching instructions for matching the bit settings designating the attributes of the print job with attributes listed in an attribute-printer assignment table, nor identifying instructions for identifying the printer to send the print job by matching attribute bit settings with those in the table.

Because Barry does not set forth each and every element of Appellant's claimed invention, Appellant respectfully requests reconsideration and withdrawal of the rejection of independent claim 8 as well as all claims depending therefrom.

(7) Barry fails to disclose the limitation of dependent claim 11.

Regarding claim 11, Barry does not disclose that a list of available printers and attributes associated with each of the available printers are entered through a graphical user interface. As Appellant discloses, the assignment of available printers to print jobs having certain attributes is

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(IBM/0010)

preferably customizable by the user through a graphical user interface. (Specification, p. 13, lines 20-23). The method and system disclosed by Barry is extremely complex with many different parameters that must be entered for the many different printer engines disclosed therein. Appellant is unable to find within Barry any disclosure that an attribute-printer assignment table is populated by entering the list of available printers and attributes of the available printers through a graphical user interface. Therefore, Appellant respectfully asserts that a *prima facie* case of anticipation has not been presented and respectfully requests reconsideration and withdrawal of the rejection of claim 11.

(8) Barry fails to disclose the limitation of dependent claim 12.

Regarding claim 12, Barry does not disclose that an attribute bit setting for each of the one or more identified attributes is set by an application program or printer handler. Barry merely discloses that a page header is generated for each page to be printed and that the page header includes, derived after rasterizing the page to be printed, the bit depth of the page, the page size, the number of colors, etc. (Barry, col. 31, lines 45-55).

It is important to note that Barry requires that a document to be printed be rasterized prior to a determination as to which printer to send the document to. As Barry states:

It should be understood that the virtual print engine of the present invention is operable to convert each of the documents *into single individual bit-mapped pages*, which images are stored on a page-by-page basis for each document. Thereafter, as described above, these pages are distributed to various engines in a parallel manner, depending upon the characteristics of the page, the availability of the engine, and, in general, how best to match a given page in accordance with its characteristics with a given engine in accordance with that engine's characteristics.

Barry, col. 16, lines 40-52.

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Barry further discloses:

The RIP 670, in addition to providing a rasterized image, also provides output information as to bit depth, resolution, number of pixels per line, etc.

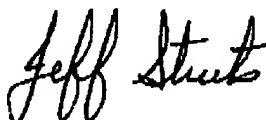
Barry, col. 31, lines 40-50.

Barry discloses the RIP to be a rasterizing program that converts a received document into individual bit-mapped pages. (Barry, col. 31, lines 25-26)

Barry does not disclose the use of an attribute bit setting for each of one or more identified attributes. Reconsideration and withdrawal of the rejection of claim 12 is requested.

Therefore, because the cited prior art reference fails to disclose each and every limitation of the claims, Appellant respectfully asserts that a *prima facie* case of anticipation has not been presented. Therefore, Appellant respectfully requests the Board to find that claims 1-6 and 8-13 presented on appeal are patentable.

Respectfully submitted,



Jeffrey L. Streets
Attorney for Appellant
Registration No. 37,453
13831 Northwest Freeway, Suite 355
Houston, Texas 77040
713-939-9444

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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IN RE APPLICATION OF:
Kulvir Singh Bhogal

SERIAL NO: 09/895,093

CONFIRMATION NO.: 6701

FILED: June 29, 2001

**FOR: Print Manager Having a User Interface
For Specifying How Documents Are
Directed to Print Devices**

EXAMINER: Gabriel I. Garcia

GROUP ART UNIT: 2624

Via Facsimile: 571-273-8300

APPENDIX IN SUPPORT OF APPELLANT'S APPEAL BRIEF

| | |
|--|----|
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(8) CLAIMS APPENDIX

What is claimed is:

1. (previously presented) A method for selecting a printer for printing a print job, the method comprising:
 - identifying one or more attributes of the print job;
 - associating an attribute bit setting for each of the one or more identified attributes;
 - matching the one or more attribute bit settings of the print job with attributes listed in an attribute-printer assignment table;
 - identifying the printer from the attribute-printer assignment table designated to handle print jobs by having the matching one or more attribute bit settings; and
 - directing the print job to the identified printer.
2. (original) The method of claim 1, further comprising:
 - generating the plurality of print jobs using one or more application programs running in a computer that is in communication with one or more printers.
3. (previously presented) The method of claim 1, wherein the one or more attributes are selected from file type, application identity, color content, print resolution, page size or combinations thereof.
4. (previously presented) The method of claim 1, wherein the attribute-printer assignment table comprises a list of available printers and the attributes associated with each of the available printers, the method further comprising:
 - entering the list of available printers and the attributes associated with each of the available printers through a graphical user interface.
5. (previously presented) The method of claim 1, wherein the attribute bit setting for each of the one or more identified attributes is set by an application program or a printer handler.

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6. (previously presented) The method of claim 5, further comprising:
storing the attribute-printer assignment table in memory for access by the printer handler.
7. (cancelled)
8. (previously presented) A computer program product including instructions embodied on a computer readable medium for selecting a printer for printing a print job, the instructions comprising:
identifying instructions for identifying one or more attributes of the print job;
associating instructions for associating an attribute bit setting for each of the one or more identified attributes;
matching instructions for matching the one or more attribute bit settings of the print job with attributes listed in an attribute-printer assignment table;
identifying instructions for identifying the printer from the attribute-printer assignment table designated to handle print jobs by having the matching one or more attribute bit settings; and
directing instructions for directing the print job to the identified printer.
9. (original) The computer program product of claim 8, further comprising:
generating instructions for generating the plurality of print jobs, wherein the generating instructions are capable of running one or more application programs in communication with one or more printers.
10. (previously presented) The computer program product of claim 8, wherein the one or more attributes are selected from file type, application identity, color content, print resolution, page size or combinations thereof.
11. (previously presented) The computer program product of claim 8, wherein the attribute-printer assignment table comprises a list of available printers and the attributes

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associated with each of the available printers, the computer program product further comprising:

entering instructions for entering the list of available printers and the attributes associated with each of the available printers through a graphical user interface.

12. (previously presented) The computer program product of claim 11, wherein the attribute bit setting for each of the one or more identified attributes is set by an application program or a printer handler.

13. (previously presented) The computer program product of claim 12, further comprising:

storing instructions for storing the attribute-printer assignment table in memory for access by the printer handler.

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(9) EVIDENCE APPENDIX

NONE

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(10) RELATED PROCEEDINGS APPENDIX

NONE